fall together." The Brief explicitly contains the statement required by the rule, and hence there is no omission as alleged in the Notification.

As explained by the Examiner in a telephone conversation conducted on August 15, 2001, the Brief is considered to be non-compliant, because it does not include a statement in Section VII ("Grouping of Claims") that claims 2-5, 16-23, 25-28, 39-45, and 60-61 (contained in a separate ground of rejection under 35 U.S.C. § 103(a)) do not stand or fall together. This assertion of non-compliance is respectfully traversed.

According to 37 C.F.R. 1.192(c)(7),

> [f]or each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone *unless* a statement is included that the claims of the group do not stand or fall together and, in the argument [section of the brief] . . . , appellant explains why the claims of the group are believed to be separately patentable. [37 C.F.R. 1.192(c)(7) (emphasis added)]

In addition,

> [i]t should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. *Where the appellant does neither, the claims will be treated as standing or falling together.*" [M.P.E.P. § 1206 (emphasis added)]

To address the rejection of claims 2-5, 16-23, 25-28, 39-45, and 60-61 under 35 U.S.C. § 103(a), Appellants have chosen to treat these claims as a single group for purposes of this Appeal. For this reason, Appellants did not include a statement in Section

VII ("Grouping of Claims") that claims 2-5, 16-23, 25-28, 39-45, and 60-61 do not stand or fall together. In addition, Appellants have not presented arguments in the Brief that these claims — all subject to the same § 103(a) rejection — are separately patentable.[1] Since neither affirmative act (A) nor affirmative act (B) were performed, claims 2-5, 16-23, 25-28, 39-45, and 60-61 should be considered as a group by default, according to M.P.E.P. § 1206.

Appellants respectfully submit that no statement is required in Section VII ("Grouping of Claims") of the Brief that claims 2-5, 16-23, 25-28, 39-45, and 60-61 should be considered as a group (i.e., *do* stand or fall together), because no such statement is required by either 37 C.F.R. 1.192(c)(7) or M.P.E.P. § 1206. It is respectfully submitted that the *only* statement that is required by either 37 C.F.R. 1.192(c)(7) or M.P.E.P. § 1206 is that "the claims of the group do *not* stand or fall together" when the claims of a group are believed to be separately patentable. [(emphasis added)] Additionally, it is respectfully submitted that neither 37 C.F.R. 1.192(c)(7) nor M.P.E.P. § 1206 require that the statement specifically delineate those claims or groups of claims which are believed to be separately patentable. Consequently, it is respectfully submitted that the Brief complies with 37 C.F.R. 192(c)(7).

In view of the foregoing, it is respectfully submitted that the Notification is in error, and should be withdrawn. Rather than belabor the issue, to move forward the

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[1] Appellants argue on page 20 of the original Appeal Brief that "the subject matter of claims 2-5, 16-23, 25-28, 39-45, and 60-61 is patentable. . . ."

appeal process in the present case, Appellants hereby submit a Substitute Appeal Brief, in triplicate, which addresses the concerns expressed by the Examiner.

Should the Examiner have any questions regarding this response, the application, or the appeal in general, the Examiner is urged to contact the undersigned.

Respectfully submitted,

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